

No. 15589

In the

**United States Court of Appeals  
For the Ninth Circuit**

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HARRY X. BERGMAN, PERMA-LOX ALUMINUM SHINGLE CORPORATION and VICTOR H. LANGVILLE, doing business under the assumed name of LANGVILLE MANUFACTURING COMPANY, *Appellants,*

vs.

ALUMINUM LOCK SHINGLE CORPORATION OF AMERICA, *Appellee.*

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**APPELLANTS' REPLY TO APPELLEE'S  
SUPPLEMENTAL BRIEF**

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On Appeal from the United States District Court  
for the District of Oregon

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Appellants have made a separate motion to strike appellee's supplemental brief on the grounds that it was filed with the Court inexcusably late. Should the Court, however, wish to consider the brief on its merits, we submit the following for the Court's consideration in addition to our opening and reply briefs filed when this cause was previously before the Court.

**THE HISTORY OF THE PATENT IN SUIT**

In order to evaluate appellee's supplemental brief and not be misled by the many inaccuracies which

are sprinkled throughout this prolix document, it is well to have in mind the basic background facts of the Korter patent. Stripped of all the verbiage with which appellee surrounds its case, the history of the Korter patent is as follows:

According to Mr. Korter (Tr. 146 et seq.), he had an idea with respect to the construction of an interlocking metal shingle and a Mr. Weber prepared drawings of the idea. These drawings (PX 17) show that Korter's idea was only for an interlocking metal shingle and there was no suggestion concerning drainage, drain slots, or removal of water of condensation. Korter gave PX 17 to his patent attorney, Mr. Birkenbeuel, who prepared a patent application (DX28) in accordance with the information contained in PX 17. This application disclosed and claimed a rectangular shingle of the interlocking type. The specification of the application contained only two brief general references to a shingle having natural or lateral drainage to take care of condensation and moisture. No specific reference was made to the open ends at the corners of the shingles and neither the specification nor the drawings contained a single reference to a drain opening, drain slot or any other such term.\* None of the

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\* Appellee's statement (Br., p. 46) that the first application referred to the drain slot as a "diagonal slot" is just another misrepresentation by appellee. Diagonal slot 19 is shown in the drawings and referred to in the specification as being a slot which separates lip 18 of the upper edge of the shingle from lip 16 of a side edge and has nothing to do with draining water from the gutter of the shingle (DX 28, pp. 4, 8).

claims ever presented in this application attempted to cover a drain opening, slot or the like. All of the claims were directed to a *combination of elements* making up an interlocking shingle. These claims were consistently and finally rejected by the Patent Office for failure to define invention over the prior art.

When it became apparent to Korter that he was not going to be successful in obtaining a patent on his interlocking shingle as such, he cast about for some slight change over the prior art which might make his shingle patentable. The idea of adding a drain slot near the corner of the shingle was hit upon and the second application (DX 29), which ultimately resulted in the patent in suit, was filed. In this application, it was clearly stated that the basis of the invention was the drain slot and drain slot 21 was shown and described as being near open corner 22 of the shingle. \* After much difficulty in the Patent Office and after at least six personal interviews with the Examiner, the second application was finally allowed with one claim.

### FILE WRAPPER ESTOPPEL

This is not a case in which an applicant for a patent just added a limitation in his claim in order to obtain al-

\* Despite the unequivocal nature of the disclosure in the Korter patent, appellee in its supplemental brief attempts to prove that the basis of the invention in the Korter patent is not a drain slot although Korter states that it is in just so many words. In his patent, column 1, beginning line 17, it is stated:

"Fig. 3 is a fragmentary perspective view of one corner of the shingle showing *the drain slot which forms the basis of this invention.*"

lowance. Korter's first application which did not disclose the "drain slot", and therefore could not claim it, was completely and finally rejected by the Patent Office for failure to define invention over the prior art and Korter acknowledged that the Patent Office was correct by abandoning prosecution of his application. In the meantime, he filed a second application like the first except that in the second a particular drain slot construction was shown, described and claimed. The patent in suit issued on the second application.

This is aggravated file wrapper estoppel in which the applicant abandoned a first application that might have covered the accused structure and filed a new application which did not. Korter, having been successful in the second application, cannot now claim as his the broader coverage which would have resulted had he been successful in the first application.

### **THE ABANDONED KORTER APPLICATION**

Appellee insists, page 32 et seq., that there is no justification for calling Korter's first application (DX 28) an abandoned one and that in fact the patent in suit was granted on both applications (p. 2). The first application was marked abandoned by the Patent Office because it *was abandoned*, Korter having acqui-



esced in the holding of the Board of Appeals of the Patent Office that it was not patentable over the prior art (stipulation dismissing with prejudice all claims in suit against Commissioner of Patents to have a patent issue on the first application, DX 28, p. 40). The fact that reference in the issued patent is made to the abandoned application as "my co-pending application, Serial No. 776,332, filed September 26, 1947, over which the shingle shown herein is an improvement.", does not establish in any way that there was patentable subject matter in the prior application.

Appellee attempts to make much of the fact that the stipulation provided for dismissal without prejudice as to any claims which the Patent Office may allow or has allowed in the application which was the subject of the suit, or in any other application. This should be of small comfort to appellee because there were no allowed claims and the dismissal naturally was effective against the only application in suit.

The significant fact which appellee would like this Court to overlook is the dismissal of the claims *with prejudice*. This, of course, meant that Korter could never again assert these claims or claims of similar scope against the Commissioner in an attempt to obtain a patent. Despite appellee's protestations to the contrary, this was an admission by Korter that the subject matter of these claims was not patentable.

## THE SECOND APPLICATION

When Korter filed his second application which resulted in the patent in issue, the only material change was the addition of the drain slot which was pointed out in the drawings, specification and claims as drain slot 21 provided *near* one corner of gutter 16 in a shingle.\*

Appellee now says that the construction and position of the drain slot are not important but "Any opening that performs that function of draining the water is a 'drain slot' within the meaning of the claim." (Br., p. 55). This, of course, is not in accord with the teachings of the Korter patent which only discloses a drain slot 21 near the corner of the shingle and does not even suggest that open corner 22 is the equivalent of the drain slot.\*\* Further, during prosecution of the application in the Patent Office, Korter, through his attorney and in order to get around the prior art, categorically stated that in his invention "there is a cut-away drain slot disposed at the bottom of the curved edge portion of the shingle and adjacent a corner thereof . . .

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\* The S-lock construction was also added but according to Korter had always been there and had been inadvertently omitted from the patent drawing (Tr. 148). We note also that the addition of this construction to the first application was refused as new matter (DX 28, pp. 15, 16). If even that could not be added to the application we cannot conceive of how Korter can now maintain that the "drain slot" was in the first application.

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\*\*On page 51 of its brief, appellee refers to "drain slot 3" and to "optional drain slot 21". The Korter patent makes no reference to a "drain slot 3" and the statement that drain slot 21 is "optional" is pure fabrication.

This drain slot and its position is an important structural feature of applicant's aluminum shingle . . ." (DX 29, p. 36).

And again on pages 72 and 73 of the file wrapper (DX 29) Korter's attorney in an affidavit pointed out that the invention was for an interlocking shingle with a drain slot "spaced or offset from the side edges of the shingle . . .".

In an attempt to overcome these embarrassing admissions, appellee cites (Br., p. 41) the Second Circuit rule that on the question of file wrapper estoppel the court will only look to see whether the patentee introduced an element to avoid the prior art and not at counsel's argument. We do not understand that this Circuit follows the Second Circuit in this particular but even if it did, file wrapper estoppel is here established by Korter's voluntarily introducing "drain slot" into his specification, drawings and claims in order to distinguish from the prior art and avoid being rejected as he had been in the case of his first application.

We believe that after the Court has studied the file wrappers of the Korter applications (DXs 28, 29), the Court will feel somewhat the same as did Judge Lemmon in *Thys Co. v. Oeste*, N.D. Calif., 1953, 114 F.Supp. 403, affirmed 219 F.2d 131, cert. denied 349 U.S. 946:

(p. 404) "After a study of the voluminous file wrapper, the Court is of the opinion that the patent was obtained—in part, at least—by progressively narrowing the claims so that they now resemble the achievement of the German specialist who kept on learning more and more about less and less, until at last he had learned everything about nothing at all!"

### INVALIDITY AND NONINFRINGEMENT

Accepting for the purposes of argument the position now taken by appellee that "drain slot" in the Korter patent means any opening at any place in the gutter of a shingle, then appellee has confirmed our contention that the patent is completely anticipated by the prior art discussed on pages 44-49 of our opening brief.

Contrary to appellee's repeated assertions, we have never maintained that the claim of the Korter patent was not of the combination type in which the drain slot was only one element in the combination. Our position has consistently been, as shown in our briefs previously filed in this case, that the file wrapper histories and prior art conclusively establish that the basis for the patent and the only possible element in Korter's claim which might distinguish it from that which was admittedly old is Korter's particular "drain slot". Even if we are wrong in our belief that the addition of this drain slot to the old combination did not

rise to the dignity of patentable invention, there is no infringement because the accused shingles do not have the "drain slot".

The Miller patent (DX 31) clearly shows in its drawings open corners in the shingle gutter. In Appendix A to our opening brief, we show Fig. 2 of the Miller patent and have marked with the letter "O" the open corners of Miller's shingle which function to drain any water that might get into the gutter or flange 11 of the shingle. Miller also states in the specification, page 1, column 1, beginning line 11:

"the interlocking connections between the shingles are so formed as to permit the free drainage of rain-water that may be driven into such connections,".

Such drainage could, of course, only take place through the open corners.

Likewise, the patent to de Sincay (DX 38) shows a metal shingle with reversely turned edges and an open corner K which acts as a drain for any water that has gotten into the gutters of the shingle. On page 4, beginning line 15 of the de Sincay patent, it is stated:

"any water which may have penetrated to a certain extent between the tiles under the action of a high wind will run off to the lower corner K of the tiles, and so onto the roof."



If the teachings of the Korter patent and the representations made by Korter to the Patent Office are to be believed, then Korter's "drain slot" is different from the open corner construction of the accused shingles and there is no infringement. On the other hand, if the representations appellee is now making to this Court that any opening for draining water is covered by the Korter claim, it is invalid in view of the prior art.

Appellee's supplemental literary effort has very firmly impaled it on the horns of a dilemma.

### THE LAW

We do not believe that the controlling authorities presented in our previous briefs concerning file wrapper estoppel, noninfringement and invalidity have been met in appellee's briefs.

At no place does appellee even attempt to answer the basic law of file wrapper estoppel as set forth in the leading cases of *Shepard v. Carrigan*, 116 U.S. 593; *Morgan Envelope Co. v. Albany Perforated Wrapper Paper Co.*, 152 U.S. 425; and particularly *Smith v. Magic City Kennel Club*, 282 U.S. 784, discussed at pages 33-36 of our opening brief.

In *Broadway Towel Supply Co. v. Brown-Meyer Co.*, 245 F. 659, and *Selectasine Patents Co. v. Prest-O-Graph Co.*, 282 F. 223 (both cases arose in the Oregon

district court), this Court followed the holding of the Supreme Court in *Knapp v. Morss*, 150 U.S. 221, 37 L.Ed. 1059, that a claim must be read and interpreted with reference to any claims that were previously rejected and acquiesced in by the patentee, and that an allowed claim cannot be construed so as to cover either what was rejected by the Patent Office or disclosed by the prior art.

We again invite the Court's attention to Judge Stephens' opinion in the recent case of *D & H Electric Company v. M. Stephens Mfg., Inc.*, (1956), 233 F.2d 879, in which this Court's reliance on the doctrine of file wrapper estoppel is reiterated.

(p. 882) "Claims of a patent must be interpreted with reference to the history contained on the file wrapper, which is nothing more than a written record of the preliminary negotiations between the applicant and the Patent Office for a patent monopoly contract."

(p. 883) "This is simply the exercise of the doctrine of 'file wrapper estoppel'—the gravamen of which is that an applicant who acquiesces in the rejection of his claim, and accordingly modifies it to secure its allowance, will not subsequently be allowed to expand his claim by interpretation to include the principles originally rejected or their equivalents."

In the *D & H Electric* case, the Court found that there was no infringement because the claim of the

patent called for "ribs extending substantially at right angles" and the ribs of the accused device extended at angles which varied between 85° and 89°. Even though the patentee had used the word "substantially" in his claim, the Court was unwilling to permit the claim to cover structures which varied only a few degrees from 90°. *A fortiori* Korter should not be permitted to interpret "drain slot" in his claim to mean any type of opening, no matter where it is placed in the gutter of a shingle.

Where a patentee has been compelled to narrow his claim by introduction of a new element he cannot, after issue, broaden the claim by dropping the element. *I. T. S. Rubber Company v. Essex Rubber Company*, 272 U.S. 429, 71 L.Ed. 335.

It is also established that where one has abandoned and withdrawn another application as a condition for obtaining the patent in suit he is estopped from contending for any construction of his present patent which would in effect cover the abandoned matter. *Frederick R. Stearns & Co. v. Russell*, 6th Cir., 85 F. 218, 225, cert. denied 171 U.S. 689; see also *Magic Light Co. v. Economy Gas-Lamp Co.*, 7th Cir., 97 F 87.

The recently decided case of *Oriental Foods, Inc. v. Chun King Sales, Inc.*, 9th Cir., 1957, 244 F.2d 909, is particularly appropriate to consideration of ques-



tions of patent validity and weight to be accorded the Trial Court's findings. As stated by Judge Barnes, p. 911:

“Our first concern is properly with the validity of the patent allegedly infringed. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 330, 65 S.Ct. 1143, 89 L.Ed. 1644. We think this device fails to meet the strict standards set up by the Supreme Court with respect to patents made up of new combinations of old elements. The basic reasoning underlying the unanimous decision of the Supreme Court in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corporation*, 340 U.S. 147, 71 S.Ct. 127, 129, 95 L.Ed. 162, requires us to reverse the decision of the District Court. There the Supreme Court found the patents invalid, despite a finding by both the District and the Circuit Courts that the patents were valid as constituting invention. There as here, the lower court relied to some degree on a wide commercial success. There as here, the District Court found a result in excess of the accumulation of results of the individual elements of the claim.”

p. 913:

“The standard of invention is written into the Constitution. The Supreme Court has held that the determination by the trial court of the question of invention need not be accorded the respect given ordinary findings of fact. \* \* \* This is not a case involving disputed evidence or the credibility of witnesses. The prime evidence is documentary, and is before this Court. Under such circumstances we have a greater discretion in deciding the validity of the patent in question.”

Appellee keeps repeating that the claim of the Korter patent is for a combination as though that were a talisman before which the prior art must crumble. Indeed, appellee goes so far as to say (pp. 8, 10, 29, 45) that none of the prior art patents relied on by us purports to cover a combination. Actually, all of the prior art patents cover combinations of elements and we pointed out with great specificity (pp. 44-47 of our opening brief) the correspondence between the elements called for in the Korter claim and the Miller patent.

Why appellee attempts to impart virtue and strength to the Korter claim because it is of the combination type is puzzling because this Court has consistently followed the Supreme Court's admonition in *Great A & P Tea Co. v. Supermarket*, 340 U.S. 147, 152, that "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements." For this Court's most recent adherence to that principle, see *Oriental Foods, Inc. v. Chun King Sales, Inc.*, *supra*, at 912.

If the Korter claim is scrutinized it will be found that the alleged unusual or surprising consequence produced from the unification of elements is that any water that gets on the back of a shingle will be permitted to run off onto the face of a lower adjacent

shingle. This result is achieved by uniting old elements without changing their respective functions.

Korter's addition of a drain slot to the old interlocking shingle produced precisely what would be expected—an additional or supplementary drainage means to assist the natural drainage (open corners) of existing shingles. As stated by appellee (p. 47): "It was merely an 'improvement' of one element—the slot—to further insure the drainage."

Even if Korter's combination resulted in an advance in efficiency or better functioning of the drainage in the old shingles, it did not amount to patentable invention (*Kwikset Locks, Inc. v. Hillgren*, 9th Cir., 1954, 210 F.2d 483).

### **TECHNICAL OBJECTIONS RAISED BY APPELLEE**

Appellee argues (Br., p. 18) that the Birch patent should not be considered by this Court because it was not included in the pretrial order of the case. The Birch patent was cited in the answer and is part of the record of the history of the Korter patent before the Patent Office (DX 29) which is undeniably of record in the case. The Trial Court considered Birch because in Finding of Fact X it expressly held that the Birch patent, along with others, did not "anticipate or in any other manner detract from the full effective coverage

of the Korter claim" (Tr. 49, 50). Obviously, any patent passed on by the Trial Court should be considered by this Court and appellee's motion to strike the Birch patent denied.

Appellee also argues against consideration of the Miller patent as well as other prior patents on the ground that appellants introduced no oral testimony concerning these patents and that, therefore, appellee did not have opportunity of cross-examination.

The subject matter of this suit is about as simple a mechanical contrivance as it is possible to imagine and many trial courts would consider it an affront for a party to try and submit expert testimony concerning such simple devices. At any rate, the prior art patents are written documents which speak for themselves and no amount of testimony could change the meaning of these documents. We are confident that this Court will have no difficulty in comprehending the patents and, rather than being under disability because of appellants' failure to submit testimony on the patents, the Court may find that its time has been saved to the extent the record has been shortened by the elimination of much unnecessary testimony.

Respectfully submitted,  
J. PIERRE KOLISCH,  
*Attorney for Appellants.*